

Application No.: 10/083,092

Case No.: 56471US010

Remarks

Claims 1 - 30 are pending. Claims 2 - 4 have been cancelled. Claims 19 - 23 and 25 - 28 have been withdrawn from consideration. Claims 1 and 24 are currently amended

Restriction Requirement

Claims 1- 30 were restricted under 35 USC § 121 as follows:

- I. Claims 1-18, 24, 29, and 30 are said to be drawn to an article, classified in Class 428, subclass 355R;
- II. Claims 19-23 are said to be drawn to a fiber impregnated article, classified in Class 428, subclass 320.2;
- III. Claim 25 is said to be drawn to an adhesive bonding method, classified in Class 156, subclass 297;
- IV. Claim 26 is said to be drawn to an adhesive bonding method, classified in Class 156, subclass 88;
- V. Claims 27 and 28 are said to be drawn to an adhesive bonding method, classified in Class 156, subclass 94.

During a telephone conversation with Examiner Keehan on April 7, 2004, a provisional election was made with traverse to select Group I, claims 1-18, 24, 29, and 30.

In response, Applicants confirm the election of Group I, with traverse. Applicants submit that a two way restriction would be proper, that is, between claims 1-24, 29, and 30 and claims 25-28.

The Restriction Requirement states in part:

Inventions of Group I and Group II are related as mutually exclusive species. The inventions of Groups I and III are related as product and process of use wherein the product can be used in a materially different process. Inventions of Groups I and IV are related as product and process of use wherein the product can be used in a materially different process. Inventions of Groups I and V are related as product and process of use wherein the product can be used in a materially different process. Inventions of Groups III to V are unrelated.

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Applicants submit that the Groups I and II claims are so interrelated that a search of one group of claims will reveal art to the other. Moreover, the classification of Groups I and II claims in different subclasses is not sufficient grounds to require restriction.

Applicants submit that the Groups III, IV, and V claims are so interrelated that a search of one group of claims will reveal art to the other. Moreover, the classification of Groups III, IV, and V claims in different subclasses is not sufficient grounds to require restriction.

Were restriction to be effected between the claims in Groups I and II and in Groups III, IV, and V, a separate examination of the claims in the above Groups would require substantial duplication of work on the part of the U.S. Patent and Trademark Office. Even though some additional consideration would be necessary, the scope of analysis of novelty of all the claims of Groups I and II and in Groups III, IV, and V, would have to be as rigorous as when only the claims of either Group I or II or any one of Groups III, IV, and V, were being considered by themselves. Clearly, this duplication of effort would not be warranted where these claims of different categories are so interrelated. Further, Applicants submit that for restriction to be effected between the claims in Groups I and II and in Groups III, IV, and V, it would place an undue burden by requiring payment of a separate filing fee for examination of the non-elected claims, as well as the added costs associated with prosecuting five applications and maintaining five patents.

Reconsideration of the Restriction Requirement is respectfully requested.

§ 102 Rejections

Claims 1, 4, 5, 8-10, 13-15, 18, 24, and 30 were rejected under 35 USC § 102(b) as being anticipated by Hoyle et al. (WO 99/64235). The Patent Office submits in part that: Hoyle et al. disclose a protective article having a backing containing a fluoropolymer that is not perfluorinated and a curable adhesive layer on at least one surface.

Hoyle et al. do not disclose a protective article having a backing containing a fluoropolymer that is not perfluorinated and a curable adhesive layer on at least one surface wherein the curable adhesive is a heat, moisture, or UV light curable thermoset adhesive layer on at least one

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unetched surface, wherein the curable thermoset adhesive layer comprises an adhesive selected from the group consisting of epoxy resins, acrylates, cyano-acrylates, and urethanes. For at least this reason, Hoyle et al. do not anticipate the invention as claimed.

Accordingly, Applicants respectfully request that the above rejection of claims 1, 5, 8-10, 13-15, 18, 24, and 30 be withdrawn.

Claims 1, 2, 6-9, 11, 24, and 29 were rejected under 35 USC § 102(b) as being anticipated by Parsonage et al. (WO 99/32557). The Patent Office submits in part that: Parsonage et al. disclose a protective article having a backing containing a fluoropolymer that is not perfluorinated and a curable adhesive layer on at least one surface; and regarding claim 11, Parsonage et al. disclose an epoxide resin by disclosing Vandenburg (U.S. 3,158,581) at page 5, lines 19-22.

Applicants respectfully traverse the above rejection because the above rejection with respect to claim 11 is improper. Vandenburg is not specifically incorporated by reference into Parsonage et al. Thus, Vandenburg is not part of the specification of Parsonage et al. For at least this reason, the above rejection with respect to claim 11 is improper.

Parsonage et al. discloses fluoropolymer backings having an elastomer on one surface of the backing. Parsonage et al. do not disclose a protective article having a backing containing a fluoropolymer that is not perfluorinated and a curable adhesive layer on at least one surface wherein the curable adhesive is a heat, moisture, or UV light curable thermoset adhesive layer on at least one unetched surface, wherein the curable thermoset adhesive layer comprises an adhesive selected from the group consisting of epoxy resins, acrylates, cyano-acrylates, and urethanes. For at least this reason Parsonage et al. do not anticipate the claimed invention.

Accordingly, Applicants respectfully request that the above rejection of claims 1, 6-9, 11, 24, and 29 be withdrawn.

Claims 1-3, 16, 17, and 24 were rejected under 35 USC § 102(b) as being anticipated by Hanson (U.S. 4,670,089). The Patent Office submits in part that: Hanson disclose a protective article having a backing containing a fluoropolymer that is not perfluorinated and a curable

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adhesive layer on at least one surface; and regarding claim 3, Hanson discloses a urethane adhesive by disclosing Blum et al. (U.S. 4,507,456) at column 3, lines 63-65.

Hanson does not disclose a protective article having a backing containing a fluoropolymer that is not perfluorinated and a curable adhesive layer on at least one surface wherein the curable adhesive is a heat, moisture, or UV light curable thermoset adhesive layer on at least one unctched surface, wherein the curable thermoset adhesive layer comprises an adhesive selected from the group consisting of epoxy resins, acrylates, cyano-acrylates, and urethanes. For at least this reason Hanson does not anticipate the claimed invention.

Accordingly, Applicants respectfully request that the above rejection of claims 1, 16, 17, and 24 be withdrawn.

§ 103 Rejections

Claim 12 was rejected under 35 USC § 103(a) as being unpatentable over Parsonage et al. in view of Neumann et al. (U.S. 5,889,125).

Parsonage et al. has been discussed above. Neumann et al. disclose curing components for epoxy resins. Parsonage et al. disclose elastomers. Epoxy resins are not elastomers. Neither Parsonage et al. or Neumann et al. provide any suggestion or motivation to combine the references as suggested by the Patent Office. Because neither of the references provide any suggestion or motivation to combine as suggested by the Patent Office, the Patent Office has failed to prove a *prima facie* case of obviousness. Accordingly, Applicants respectfully request that the above rejection of claim 12 be withdrawn.

Claims 2, 6, and 11 were rejected under 35 USC § 103(a) as being unpatentable over Parsonage et al. in view of Vandenburg (U.S. 3,158,581).

Parsonage et al. has been discussed above. Vandenburg discloses polymeric epoxides. Parsonage et al. disclose elastomers. Polymeric epoxides are not elastomers. Neither Parsonage et al. nor Vandenburg provide any suggestion or motivation to combine the references as

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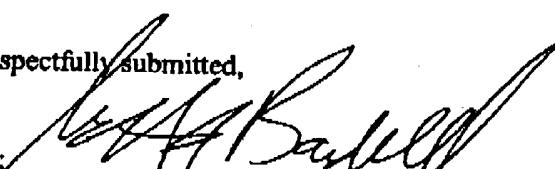
suggested by the Patent Office. Because neither of the references provide any suggestion or motivation to combine as suggested by the Patent Office, the Patent Office has failed to prove a prima facie case of obviousness. Accordingly, Applicants respectfully request that the above rejection of claims 6 and 11 be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

30 July, 2004
Date

Respectfully submitted,

By:


Scott A. Bardell, Reg. No.: 39,594
Telephone No.: (651) 736-6935

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833